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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,272	02/08/2002	Greg A. Penner	11898.0021.NPUS00 (MOBS:0	9001

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EXAMINER	
KRUSE, DAVID H	
ART UNIT	**PAPER NUMBER**
1638	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding..

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/071,272	PENNER ET AL.	
	Examiner	Art Unit	
	David H. Kruse	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-18* is/are pending in the application.

4a) Of the above claim(s) *14 and 15* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group II, claims 16-18, in the reply filed on 4 December 2006 is acknowledged.

2. Claims 14 and 15 are withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4 December 2006.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR § 1.48(b) and by the fee required under 37 CFR § 1.17(i).

Information Disclosure Statement

4. The listing of references in the specification on page 32 is not a proper information disclosure statement. 37 CFR § 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Priority

Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. § 119(e) or under 35 U.S.C. § 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 119(e) as follows: The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Provisional Application No. 60/267,551, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. § 112 for one or more claims of this application. Said application describes harvesting all seed produced from a mixed planting of homozygous yellow and homozygous black seed at pages 21-23, and thus does not support step "ii)" of instant claim 16.

Adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. § 112 for one or more claims of this application is found in Provisional Application 60/327,801, filed 9 October 2001, hence the instant claims are given that priority date for the purposes of applying the prior art.

Claim Objections

Claims 17 and 18 objected to under 37 CFR § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 17 and 18 fail to further limit claim 16 directed to a method of generating soybean seed heterozygous for seed coat color, but appear to be directed to a method of using seed produced by the method of claim 16.

Claim Rejections - 35 USC § 112

5. Claims 16-18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 is indefinite because there is no recitation of any crossing steps in the claim, just planting, harvesting and replanting. As the instant art recognizes that there is very little if any out-crossing in soybeans, it is unclear how one generates soybean seed heterozygous for seed coat color just by random chance. Hence, the metes and bounds of the claim are unclear. Claims 17 and 18 are also indefinite as they depend from claim 16.

At claim 17 iii), the limitation "the yellow seed coat variety" lacks proper antecedent basis in claim 16. Appropriate correction is required.

At claim 18, 2nd line, "the commercial cultivar seeds" lacks proper antecedent basis in the claim(s) upon which it depends. Appropriate correction is required.

6. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 16-18 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicants claim a method of generating soybean seed heterozygous for seed coat color of cultivars containing proprietary traits. At page 4, lines 27-28, Applicants define "proprietary traits" as "a trait for which a patent position is held, and/or is managed as a trade secret[1] by the proprietor".

The instant claims lack enablement because "proprietary traits" by their very definition are not publicly available, and since the "cultivars that contain the proprietary traits" are required to practice the claimed method, one of skill in the art at the time of Applicants' invention could not have been able to use the invention as claimed. See *Ex parte Humphreys* 24 USPQ2d 1255, 1259 (BdPatApp&Int, 1992) which teaches that the ability of others to obtain material from a third party prior to and after the filing date of an

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[1] Black's Law Dictionary (8th ed. 2004), trade secret
trade secret. 1. A formula, process, device, or other business information that is kept confidential to maintain an advantage over competitors; information -- including a formula, pattern, compilation, program, device, method, technique, or process -- that (1) derives independent economic value, actual or potential, from not being generally known or readily ascertainable by others who can obtain economic value from its disclosure or use, and (2) is the subject of reasonable efforts, under the circumstances, to maintain its secrecy.

application does not establish that upon issuance of a patent on such application that such material will continue to be accessible to the public.

The issue of using a trade secret makes the instant claims non-enabled (see definition above). A trade secret by its very definition is not something that is enabled or publicly available to one of skill in the art to use. It is Applicants' burden to teach one of skill in the art how to make and use the invention, but if a critical material required to use the invention is not publicly available, it is unclear how one skilled in the art would be able to practice the invention as claimed.

See *In re Sarkar*, 575 F.2d 870, 872, 197 USPQ 788, 791 (CCPA 1978), which stated:[T]hat wherever possible, trade secret law and patent laws should be administered in such manner that the former will not deter an inventor from seeking the benefit of the latter, because, the public is most benefited by the early disclosure of the invention in consideration of the patent grant. If a patent applicant is unwilling to pursue his right to a patent at the risk of certain loss of trade secret protection, the two systems will conflict, the public will be deprived of knowledge of the invention in many cases, and inventors will be reluctant to bring unsettled legal questions of significant current interest ... for resolution.

Applicant teaches that multiple loci control soybean seed coat color at pages 6-7 of the instant specification. There is no recitation in the instant claims of what the genotype of the "black seed coat soybean" has, hence it appears that it would have required undue trial and error experimentation by one of skill in the art at the time of Applicant's invention to use the method as broadly claimed.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claim 16 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Webb (U.S. Patent 5,491,081) in view of Lewers *et al* 1996 (Crop Science 36:1560-1567).

Applicant claims a method of generating soybean seed heterozygous for seed coat color of cultivars containing proprietary traits, the method comprising planting homozygote black seed coat soybean plants in separate, alternate rows in the same field as cultivars that contain the proprietary traits and that are not homozygote black seed coat soybean plants.

Web teaches crossing soybean variety PI437654 having black seed color with elite soybean varieties at column 1, last paragraph.

Lewers *et al* teach methods of crossing soybean plants.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The instant claims do not recite a crossing steps just planting in proximity. It would have been obvious to one of ordinary skill in the instant art at the time of Applicants' invention that planting soybean varieties in close proximity implies a crossing steps can be practices. Elite soybean varieties were well known at the time of Applicants' invention, especially the Roundup Ready™ varieties. Lewers *et al* teach that planting soybeans in alternate rows in the same field for crossing was well know in the art at the time of Applicants' invention. In addition, the process of multiple crosses was know to those of ordinary skill in the instant art. The instant claim is *prima facie* obvious because it reads on a modified method of ingressing traits from black seeded soybean plants that were know in the art into elite soybean lines, especially in view of the open claim language used in the instant claim.

Conclusion

10. Claims 17 and 18 are free of the prior art because in the instant art the presence of off color soybean seed, especially black seed, mixed with yellow seeded soybeans would have been considered undesirable, hence the art would teach away from the invention of said claims.

11. No claims are allowed.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (571) 272-0799. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached at (571) 272-0975. The central FAX number for official correspondence is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (571) 272-1600.

DAVID H. KRUSE, PH.D.
PRIMARY EXAMINER

David H. Kruse, Ph.D.
1 March 2007

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

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